

REMARKS

Claim 21 has been amended. No claims have been canceled or added. Accordingly, claims 17-34 are currently pending in the application.

Priority

Applicants request that the Examiner acknowledge the claim for priority. The certified priority document was filed in the parent application on June 24, 2004. A copy of the mailroom, date-stamped receipt is enclosed.

Double Patenting Objection

The Examiner has rejected the pending claims as being directed to the "same invention" as that contained in copending application Serial No. 10/095,582. Applicants respectfully disagree.

Although the claims do not require any amendment, Applicants have nonetheless amended the claims in the copending application to further clarify the distinctions between the two applications. If the claims in each application are properly considered in light of the specification, it should be understood that the phrases "a

storage system" and "a plurality of storage systems" have different meanings and therefore have different scope. In such a case, it is improper for the Examiner to raise a "same invention" type of double-patenting rejection (also known as Statutory Double Patenting).

As set forth in MPEP §804(II)(A), a reliable test for double patenting of this type is "whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent" (in this case, another application). This portion of the MPEP refers to an example of a claim reciting a compound having a "halogen" substituent versus a claim being identical except having a "chlorine" substituent. In this case, a same invention double patenting rejection cannot be applied.

This portion of the MPEP also compares a claim reciting a widget having a length "36 inches" and having another claim reciting a widget having a length of "3 feet". Clearly, in this case, a same invention type double patenting rejection would be appropriate.

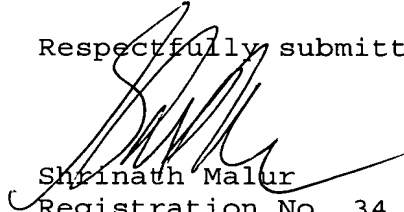
However, when comparing the claims pending in this application and related application Serial No. 10/095,582, it can easily be seen that one set of claims recites a "storage system" while the other set recites a "plurality of storage

systems". Therefore, it should be clear that a computer system that has a single storage system would not literally infringe a claim that recites a "plurality of storage systems". Therefore, the claims are of different scope. In order to expedite the prosecution of this application, a terminal disclaimer is being filed so as to obviate any potential obviousness-type double patenting rejection.

Conclusion

In view of the foregoing amendments and remarks, Applicants contend that the above-identified application is now in condition for allowance. Accordingly, reconsideration and reexamination are respectfully requested.

Respectfully submitted,

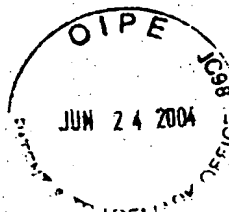

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In re Patent Application of

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Serial No. 09/642,817

Group Art Unit: 2187

Filed: August 22, 2000

Examiner: N. Moazzami

For: A COMPUTER SYSTEM AND A METHOD OF ASSIGNING
A STORAGE DEVICE TO A COMPUTER

Papers Filed Herewith:

Transmittal Letter;
AMENDMENT;
Certified Priority Document (JP 11-241024);
INFORMATION DISCLOSURE STATEMENT,
PTO-1449 Form and cited references.

Receipt is hereby acknowledged of the papers filed, as
identified in connection with the above-identified patent
application.

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